

REMARKS

Claims 1-12 and 14-22 constitute the pending claims in the present application. Claims 2-4 and 20 stand as rejected by the Examiner. Claims 1, 5-12, 14-19, and 21-22 are objected to. Applicants amend claim 5 to correct typographical errors. Claims 1, 3, 5-7, and 18 are amended to address the Examiner's objection. Claim 16 is amended to address the Examiner's rejection. Applicants assert that these amendments present no new matter.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner are addressed below in the order they appear in the prior Office Action.

I. Claim Rejections – 35 U.S.C. 112 First Paragraph – Claim 20

Claim 20 is rejected under 35 U.S.C. 112 first paragraph for allegedly failing to comply with the written description requirement. Applicants traverse the rejection.

The Office states that the "specification defines R³ as -OC₁₋₅alkylR⁴², and it is R⁴² that can be 3-morpholinopropoxy. Therefore, to recite R³ as 3-morpholinopropoxy would not be inconsistent [sic] with the definition in the specification." Applicants assert that the Examiner is misinterpreting the definition at page 17, lines 23-24 of the specification. The phrase "such as 3-morpholinopropoxy" is intended to exemplify the "group OC₁₋₅alkylR⁴²", not the "N-linked morpholine ring" as the Examiner has interpreted it. Applicants have amended the specification to clarify the relationship, consistent with the numerous examples, e.g., 32-43 and 45-50, in the specification. Withdrawal of the rejection is respectfully requested.

2-3. Claim Rejections – 35 U.S.C. 112 Second Paragraph – Claims 2-4

Claims 2-4 are rejected under 35 U.S.C. 112 second paragraph for allegedly possessing insufficient antecedent basis for the limitation "or combination thereof" in claim 2. Applicants traverse the rejection.

The Examiner rejects claim 2, which recites in the definition of R¹⁶ "or combination thereof," because the claim from which it is dependent, claim 1, does not recite the "or combination thereof" limitation. Applicants respectfully point out that claim 1 defines that R¹⁶ may be "optionally substituted hydrocarbyl," and that the specification on page 5, lines 8-9 has defined that hydrocarbyl "may be alkyl, alkenyl, alkynyl, aryl, aralkyl, cycloalkyl, cycloalkenyl

or cycloalkynyl, or combinations thereof" (emphasis added). It is this definition that forms the basis of the recitation in claim 2 that the Examiner has objected to, and thus the recited combinations of substituents in claim 2 are entirely encompassed and contemplated by the term "optionally substituted hydrocarbyl" in claim 1. Hence, the recitation of "or combination thereof" in claim 2 requires no further antecedent basis. If the Examiner feels that amendment is necessary to resolve this situation, Applicants will consider any reasonable suggestions. Otherwise, Applicants request reconsideration and withdrawal of the rejection.

4. Claim Objections – Parenthetical Phrases – Claims 1-12 and 14-22

Claims 1-12 and 14-22 are objected to because the compounds contain parenthetical phrases. Although Applicants submit that these phrases do not render the claims unclear or otherwise unpatentable, claims 1, 3, 5-7, and 18 are amended to remove all parenthetical phrases. Applicants submit that the scope of these claims is not narrowed by this amendment. Reconsideration and withdrawal of the objection is requested.

5. Claim Objections – Multiple Dependent Claim – Claims 16-22

Claims 16-22 are objected to under 37 CFR 1.75(c) as allegedly being of improper form. The Office contends that claim 16 is a multiple dependent claim. Applicants disagree and assert that reference to claims 1 and 6 in objected claim 16 is for the purpose of defining variables therein and not for establishing dependencies on embodiments covered in these claims. Unamended claim 16 recites: "A compound according to claim 10 or a salt, ester or amide thereof; where X is as defined in claim 1 and R¹, R², R³, R⁴ are as defined in claim 6; and..." (emphasis added). Pursuant to MPEP 2173.05(f), "A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing..." Thus Applicants assert that claim 16 is not of improper form. However, for the purpose of advancing prosecution, Applicants amend claim 16 to no longer refer to claims 1 and 6. Applicants highlight that, in conformity with CFR 1.75(c), "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim," so the definitions of X, R¹, R², R³, and R⁴ are incorporated into claim 16 via dependency on claim 10, which is dependent on claim 6, which is dependent on claim 1. Withdrawal of the objection is respectfully requested. Since

claims 17-22 are dependent from claim 16 and recite further limitations thereon, Applicants also request reconsideration and withdrawal of the objection for these claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to Deposit Account No. 18-1945.

Respectfully Submitted,

Date: January 21, 2005



David P. Halstead
Reg. No. 44,735

Customer No: 28120
Docketing Specialist
Ropes & Gray LLP
One International Place
Boston, MA 02110
Phone: 617-951-7000
Fax: 617-951-7050